

REMARKS

Status of the Claims

Claims 1, 6-14, 19 and 22-24 are pending. Claim 1 is independent. Claims 22-24 are withdrawn from consideration as being directed to non-elected subject matter.

Claims 2-5, 15-18, 20-21 and 25 were previously canceled without prejudice or disclaimer of the subject matter contained therein.

Claim 1 has been amended to incorporate a change suggested by the Examiner in the outstanding Office Action.

No new matter has been added. Reconsideration of this application, as amended, is respectfully requested.

Priority under 35 U.S.C. § 119

Applicants thank the Examiner for acknowledging Applicants' claim for foreign priority under 35 U.S.C. § 119, and receipt of the certified priority documents.

Information Disclosure Citation

Applicants thank the Examiner for considering the references supplied with the Information Disclosure Statement filed May 16, 2011, and for providing Applicants with an initialed copy of the PTO-SB08 forms filed therewith.

Obviousness-Type Double Patenting Rejection

Claims 1, 6-14, 19 and 21-24 stand rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-21 of U.S. Patent No. 7,534,494. This rejection is respectfully traversed.

A complete discussion of the Examiner's rejection is set forth in the Office Action, and is not being repeated here.

While not conceding the appropriateness of the Examiner's rejection, but merely to advance prosecution of the instant application, Applicants submit herewith a Terminal Disclaimer disclaiming the terminal portion of any patent granted on the present application

which would extend beyond the expiration of U.S. Patent No. 7,534,494. In legal principle, the filing of a TD simply serves the statutory function of removing the rejection of obviousness-type double patenting, and does not raise a presumption on the merits of the rejection. It is improper to view the simple expedient of "obviation" as an admission or acquiescence on the merits. *Ortho Pharmaceutical Corp. v. Smith*, 22 USPQ2d 1119, 1124 (Fed. Cir. 1992) citing *Quad Envtl. Technologies Corp. v. Union Sanitary Dist.*, 946 F.2d 870, 874, 20 USPQ2d 1392, 1394-95 (Fed. Cir. 1991).

Based on the foregoing, the obviousness-type double patenting rejection is rendered moot.

Rejection under 35 U.S.C. § 102(a)

Claims 1, 6-14 and 19 stand rejected under 35 U.S.C. § 102(a) as being anticipated by Wakita et al. (WO 2004/050363).

This rejection is respectfully traversed.

With respect to Wakita et al., this WO publication published in the Japanese language on **June 17, 2004** (and as such, WO 2004/050363 is not available under 35 U.S.C. § 102(e)). However, Wakita et al. is available under 35 U.S.C. 102(a), since it published within one year of the effective US filing date of the present application, i.e., **September 30, 2004**.

Applicants herein remove Wakita et al. from the prior art by filing verified English translations of the instant priority documents:

2003-345297 (filing date **October 3, 2003**),
2003-358542 (filing date **October 17, 2003**) and
2003-361801 (filing date **October 22, 2003**).

In view of the fact that the instant priority documents adequately support the inventive claims under 35 USC 112, first paragraph, this rejection is rendered moot.

Rejections under 35 U.S.C. § 102(b) and 103(a)

The following rejections are pending:

- (A) Claims 1, 6-14 and 19 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Ikuta et al. (WO 2003/118839); and
- (B) Claims 1, 7-14 and 19 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Ikuta et al. (U.S. 2003/0118839).

These rejections are respectfully traversed. Reconsideration and withdrawal thereof are respectfully requested.

A complete discussion of the Examiner's rejection is set forth in the Office Action, and is not being repeated here.

With respect to **Ikuta et al.**, the Examiner will recall that this reference was previously cited in the May 11, 2011 Office Action. In Applicants' August 10, 2011 Amendment, Applicants argued that Ikuta et al. requires vulcanization, whereas the inventive molded composite article has the non-urethane thermoplastic resin and a resin member comprising a thermoplastic polyurethane resin "directly joined with each other" (i.e., not vulcanized).

The Examiner essentially agrees with Applicants' arguments, but the Examiner has taken the position that the term "joined" encompasses a vulcanized joining of layers. The Examiner suggests that Applicants amend claim 1 by replacing the term "joined" with "bonded" as set forth in paragraph "79" on page 10 of the Office Action in order to overcome the rejections based on Ikuta et al.

In view of the fact that Applicants have amended claim 1 as suggested by the Examiner, i.e., to replace the term "joined" with "bonded", a *prima facie* case of obviousness cannot be said to exist. Reconsideration and withdrawal of the rejection are respectfully requested.

Conclusion

All of the stated grounds of rejection have been properly traversed, accommodated, or rendered moot. Applicants therefore respectfully request that the Examiner reconsider all presently outstanding rejections and that they be withdrawn. It is believed that a full and

complete response has been made to the outstanding Office Action, and as such, the present application is in condition for allowance.


In view of the above amendment, Applicants believe the pending application is in condition for allowance.

Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact Eugene T. Perez, Registration No. 48,501, at the telephone number of the undersigned below to conduct an interview in an effort to expedite prosecution in connection with the present application.

If necessary, the Director is hereby authorized to charge any fees required during the pendency of the above-identified application or credit any overpayment to Deposit Account No. 02-2448.

Dated: NOV 28 2011

Respectfully submitted,

By 
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Attachments:

- Terminal Disclaimer
- Verified English translations of priority Japanese Patent Applications (3)